

APPLICANT ARGUMENTS OR REMARKS

Claims 1-2, 6- 10, 14-18 and 22-28 are now in the application. Claims 1, 9 and 17 are amended. Claim 28 is new. Claim 1, 9, 17 and 28 are independent claims.

Claim Objections.

The Office Action objects to claims 1-2, 6- 10, 14-18 and 22-27 because lines 28, 27 and 28 allegedly have the phrase “ thereby automatic creation”. Applicants respectfully submit that the actual phrase used is “thereby automating creation of an electronic document”, that is both grammatically correct and conveys applicants’ intended meaning of automating the process of creating an electronic document. Applicants, therefore, request that this objection be withdrawn and claims 1-2, 6- 10, 14-18 and 22-27 allowed.

Claim 27 is objected to for reciting “the method of claim 17”, when claim 17 is a computer program product. Claim 27 has been amended to recite “the computer program product of claim 17”. Applicants, therefore, request that this objection be withdrawn and claim 27 be allowed.

Claim Rejections under 35 U.S.C. 112

The Office Action rejects claims 1-2, 6- 10, 14-18 and 22-27 under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement.

In particular claims 1, 9 and 17 are rejected to for containing the limitation “enhanced HTML pages, containing said source HTML files”. Claims 1, 9 and 17 have been amended to recited “enhanced HTML pages, containing said source page files”. The term “source page files” is described in the application as published at, for instance, [0042]. The concept of the enhanced HTML page containing the source page files is clearly illustrated in the application in, for instance, figure 2A.

Claims 1, 9 and 17 are rejected to for containing the limitation “specifying characteristics of the visual appearance of the electronic document adjacent to said source HTML file”. Claims 1, 9 and 17 have been amended to recite “a visual appearance of the electronic document framing said source page file”. The term “source page files” is described in the application as published at, for instance, [0042]. The concept of the electronic document framing said source page file” is clearly illustrated in the application in, for instance, figure 3.

By these amendments, applicants submit that claims 1-2, 6- 10, 14-18 and 22-27 now comply with 35 U.S.C. 112, first paragraph. Applicants, therefore, requests that these rejections be withdrawn and claims 1-2, 6- 10, 14-18 and 22-27 allowed.

The Office Action rejects claims 1-2, 6- 10, 14-18 and 22-27 under 35 U.S.C. 112, second paragraph, for failing to particularly point out and distinctly claim the invention.

In particular, claims 1, 9 and 17 recite the limitation “said HTML file” in line 19. Applicant has amended claims 1, 9 and 17 to recite “said source page files”.

Claims 1, 9 and 17 recited the limitation “said template specifying characteristics of the visual appearance of the electronic document adjacent to said HTML page file. Applicants have amended claims 1, 9 and 17 to now recited “said template specifying a visual appearance of the electronic document framing said source page file”. The term “source page files” is described in the application as published at, for instance, [0042]. The concept of the template specifying a visual appearance of the electronic document framing the source page files is clearly illustrated in the application in, for instance, figure 3.

By these amendments, applicants submit that claims 1-2, 6- 10, 14-18 and 22-27 now comply with 35 U.S.C. 112, second paragraph. Applicants, therefore, requests that these rejections be withdrawn and claims 1-2, 6- 10, 14-18 and 22-27 allowed.

Claim Rejections under 35 U.S.C. 102

The Office Action rejects claims 1-2, 6- 10, 14-18 and 22-27 under 35 U.S.C. 102(b) as being anticipated by DeRose et al. (US Patent 6,167,409).

DeRose describes a method of converting an electronic document in one form of markup language to an electronic document in a second from of markup document, in particular converting from SGML to HTML, as detailed in, for instance, paragraph 7, lines 7-9.

Applicants invention, in contrast, starts with an original printed document and automatically incorporates the document into web pages, with easily generated linear and hierarchical navigation and framed in a way that the document blends into an existing website, as shown in, for instance figure 3 and figure 4.

To clarify this distinction, applicants have amended claims 1, 9 and 17 to recited “a printed source document comprising sequentially numbered source pages” and have included

new claim 28 that recites "a source document, said source document comprising a paper document having two or more sequentially numbered pages and a table of contents".

As DeRose does not teach starting from a printed source document, DeRose does not anticipate applicants' claimed invention of claims 1, 9, 17 and 28. Applicants, therefore, request that this rejection be withdrawn and claims 1, 9, 17 and 28 be allowed.

As claims 2, 6-8, 10, 14-16, 18 and 22-27 each depend from, and include all the limitations of, a now allowable independent claim, they too are in condition for allowance. Applicant therefore requests that these claims now be allowed.

Summary

Therefore in view of the foregoing amendments and remarks, applicants respectfully request entry of the amendments, favorable reconsideration of the application, withdrawal of all rejections and objections and that claims 1-2, 6- 10, 14-18 and 22-28 be allowed at an early date and the patent allowed to issue.

Respectfully submitted,

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